

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jean-Michel STURLA et al.

Application No.: 09/385,412

Filed: August 30, 1999

For: AEROSOL DEVICE CONTAINING A
POLYCONDENSATE COMPRISING
AT LEAST ONE POLYURETHANE
AND/OR POLYUREA UNIT



Group Art Unit: 1619

Examiner: R. BAWA

Assistant Commissioner for Patents
Washington, D.C. 20231

REQUEST FOR RECONSIDERATION

Sir:

In response to the Office Action dated July 20, 2000, Applicants respectfully request that the rejection and objections set forth in the Office Action be reconsidered and withdrawn in view of the following remarks. Currently, claim 1 is pending in this application.

I. *Informal Specification*

The Office objects to the specification, asserting that the arrangement of the specification is informal. The Office then suggests a "preferred" arrangement for the specification. Office Action at paragraph 1. Applicants thank the Office for indicating a "preferred" arrangement for the specification. However, another preferred arrangement for the specification is the

arrangement that Applicants filed. Applicants respectfully submit that the specification, as filed, satisfies all of the relevant statutes for a U.S. patent specification, including language, content, and format. Therefore, the specification, as filed, is satisfactory for the purposes of examination and patenting of this application. Accordingly, Applicants respectfully request withdrawal of the objection to the specification as informal.

II. *Rejection Under 35 U.S.C. § 102(b)*

The Office rejects claim 1 under 35 U.S.C. § 102(b) as anticipated by Thomaides *et al.* (U.S. Patent No. 5,626,840) or WO 94/3510. Office Action at paragraph 2. Applicants respectfully traverse this rejection and submit that the rejection is improper.

In the rejection, the Office asserts that the presently claimed invention is directed to a "composition per se", and that the cited art discloses the claimed composition. Applicants respectfully submit that the presently claimed invention is directed to a device, not a composition. *See* claim 1.

Applicants respectfully submit it is well known that, in order to anticipate a claim, a reference must disclose each and every element or component of the claim. Thus, to anticipate claim 1, both Thomaides *et al.* and WO 94/3510, individually, must disclose all of the elements recited in the device of claim 1, not just the polycondensate recited in that claim. However, the Office does not indicate where, in either of the cited references, each and every element and/or component of present claim 1 is disclosed. Because the Office has failed to indicate where each and every element and component of claim 1 is disclosed in the cited references, the rejection of

claim 1 is improper, and Applicants submit that the rejection should be withdrawn. Applicants further submit that, if the Office rejects claim 1 in response to this Request for Reconsideration, the rejection must be made non-final, since claim 1 has not yet been properly rejected a first time.

Finally, even though the Office failed to indicate where the cited references disclose each and every element and component of the device of claim 1, in an effort to expedite allowance of this application, Applicants attempted to identify where the cited references disclose the device of claim 1. However, Applicants were unable to identify a disclosure of the device of present claim 1 in either of the references. Therefore, Applicants respectfully submit that claim 1 is not anticipated by either Thomaides *et al.* or WO 94/3510, and request that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn.

For at least the reasons set forth above, Applicants submit that the rejection of claim 1 is improper, and that the Office has failed to set forth a *prima facie* case of anticipation against claim 1. Therefore, Applicants request withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated over Thomaides *et al.* or WO 94/3510.

III. *Conflicting Claims*

The Office objects to claim 1, asserting that present claim 1 and the claims of U.S. applications 09/385,015, 09/385,003, and 09/395,009 conflict. The Office requires that the conflicting claims be eliminated in all but one application. Office Action at paragraph 3.

Applicants respectfully submit that the Office has failed to indicate which claims of U.S. applications 09/385,015, 09/385,003, and 09/395,009 conflict with claim 1 of the present

application, and why they conflict. In the absence of a listing of claims and a reason for asserting that the claims conflict, Applicants cannot respond to this objection. Thus, Applicants respectfully request that the Office clarify this objection.

IV. *Conclusion*

Applicants respectfully submit that the presently claimed invention is patentable over the cited art for at least the reason given above. Applicants respectfully request that the Office withdraw the rejection of claim 1 and the objection to the specification and claim 1, and permit this application to issue as a U.S. patent. If the Office believes anything further is necessary in order to place this application in even better condition for allowance, Applicants' undersigned representative may be contacted at the telephone number or e-mail address listed below so that the necessary information or material can be provided. Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account

No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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By:


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